

REMARKS

This application has been carefully reviewed in view of the above-referenced Non-Final Office Action and reconsideration is requested in view of the following remarks. Applicants' representative has attempted to contact the Examiner to discuss the proposed claim amendments, but such efforts were unsuccessful. Accordingly, Applicants' representative respectfully requests a telephone interview to discuss the proposed claim amendments at the Examiner's earliest convenience.

Regarding the Rejections under 35 U.S.C. §103

Claims 1-19, 21-26, 28-32, and 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio et al. (US 2004/0039821, hereinafter "Giglio") in view of Arnold et al. (US 2005/0108769, hereinafter "Arnold") and further in view of Larson et al. ('DNS on Windows 2000', hereinafter "Larson"), Muoko et al. (US Pat 6,678,732), hereinafter "Muoko") and Stapp et al. (US Pat 7,152,117, hereinafter "Stapp"). These rejections are respectfully traversed. In order to establish *prima facie* obviousness, it is first necessary for the Office to find each and every claim element of the claims.

The as-filed application recites a peer-to-peer terminal communication environment at a subscriber site for a subscriber to Cable Television where the subscriber site comprises multiple terminals which may share content and program information among the terminals (See Fig. 2 of the as-filed drawings). The subscriber site advantageously uses DHCP services to establish the scope and addressable naming for terminals within the subscriber site. With these parameters established, the terminals at the subscriber site may establish a common time base, synchronize the information contained in the databases among the terminals, and communicate profile management information, content, and other information among terminals. Thus, if a program is received at one terminal from the Cable Television system, this content may be shared among terminals at the subscriber site without resorting to control mechanisms outside of the subscriber site due to the synchronization and sharing of received content among all terminals at the subscriber site.

In the as-filed claims, claims 1, 9, 11, and 32 as amended recite at least “carrying out a periodic discovery process by attempting to contact each terminal within the sub-domain within the scope of the subscriber site defined by the DHCP option 43” and “for each terminal at the subscriber site identified in the periodic discovery process, synchronizing a database according to a common timestamp with a database residing at an identified terminal,” and claims 19 and 26 as amended recite at least “carrying out a periodic discovery process by attempting to contact each terminal within the sub-domain within the scope of the subscriber site defined by the DHCP option 43” and “synchronizing a database with a database residing at the identified terminal according to a common timestamp for each terminal.” Support for the current amendments may be found, for example, on page 8, lines 12-13 and page 11, lines 8-24 of the as-filed specification.

The Giglio reference discloses the use of DHCP processes upon bootstrapping, but provides no disclosure or teaching for either a periodic discovery process or synchronizing a database within the terminals according to a common timestamp as recited in claims 1, 9, 11, 19, 26 and 32 as amended. The Giglio reference is completely silent with regard to the recited amendments and the Office must therefore look to the Arnold, Larson, Mouko and Stapp references to remedy this lack of disclosure. However, each of the secondary references is equally silent with regard to the recited amendments.

The Arnold reference discloses in paragraphs [0113] and [0114] the synchronization of data content from one DVR to a second DVR. However, this disclosure is not dependent upon a common timestamp and provides no teaching for a periodic discovery process to determine each terminal within the sub-domain as established by the DHCP process at the subscriber site. Thus, the Arnold reference is silent with regard to these features of the claims as amended and does not remedy the lack of teaching or disclosure in the Giglio reference.

Likewise, the Larson reference provides the disclosure for a plurality of terminals having addresses that may be discovered through the use of DHCP, but is equally silent with regard to a common timestamp and provides no teaching for a periodic discovery process to determine each terminal within the sub-domain at the subscriber site. Thus, the Larson reference is silent with

regard to these features of the claims as amended and does not remedy the lack of teaching or disclosure in the Giglio reference as well.

The Muoko reference discloses DHCP servers containing processes for the allocation of IP addresses for a plurality of terminals that are in communication with the server. However, the Muoko reference does not disclose or teach a common timestamp for the synchronization of data content between terminals within a subscriber site because in the disclosure in Muoko the communication is between the server and the terminals connected to the server. Thus, there is no disclosure or teaching for a periodic discovery process for terminals at a subscriber site or the synchronization of such terminals at the subscriber site based upon a common timestamp for these terminals. Thus, Muoko is silent regarding the features of claims 1, 9, 11, 19, 26 and 32 as amended and does not remedy the lack of disclosure in the Giglio reference.

The Stapp reference discloses that each DHCP server maintains a pool of available IP addresses and a data structure where IP addresses already leased are stored. The responses from the DHCP servers take the form of "offers" of data. In a subsequent message, the DHCP client notifies the servers that one of the offers is accepted. The host that is executing the DHCP client then uses the configuration information including the address. Once again, this disclosure provides for the communication between a DHCP server and a plurality of terminal devices. There is no disclosure or teaching for a periodic discovery process for terminals at a subscriber site or the synchronization of such terminals at the subscriber site based upon a common timestamp for these terminals. Thus, the Stapp reference does not provide the disclosure necessary to remedy the lack of disclosure or teaching in the Giglio reference.

Thus, even the combination of six references as asserted (Giglio, Arnold, Larson, Muoko and Stapp apparently also plus RFC 2131) does not provide the disclosure necessary to establish *prima facie* obviousness for at least claims 1, 9, 11, 19, 26 and 32. Reconsideration and early allowance are therefore respectfully requested.

In addition to the above, it is noted that the undersigned conducted a telephone interview with Examiner Beliview of May 27, 2009 after the prior Office Action. At that time the undersigned argued that he is unable to find a teaching in Giglio of "wherein the DHCP services

use DHCP option 43 to define a scope of the subscriber site in which the scope is defined to be equal to a maximum number of potential peer terminals at the subscriber site”. The DHCP services of Giglio cannot be found by the undersigned to disclose that the pool is equal to the above definition with reference to the subscriber site. Multiple references to this feature are present in the claims.

During the interview, Examiner Beliveau indicated that the claims could be read on an arrangement wherein the entire pool of IP addresses could be assigned to one subscriber site and suggested the language of claim 1 could be amended to remedy this by using language such as “equal to a subset of the maximum number of potential terminals residing at the subscriber site” or the like and by clarification of the location of the DHCP server. Applicants made such amendments and are happy to further clarify the language if need be. At this point, however, it is believed clear that an understanding as to the intended scope of the claims has been reached, and the undersigned requested the courtesy of a telephone call should further clarification be needed. No such call was received and attempts to reach the Examiner were unsuccessful.

In view of this amendment (an amendment suggested by the Examiner), it is believed that the reading taken by the Office of the claim scope is no longer viable and the teaching of Giglio is now clearly inadequate to meet this claim feature. Accordingly the combination fails to establish prima facie obviousness. However, the Office persists in asserting that “scope is IP address pool” and references RFC 2131 (page 3).

The Applicants are permitted to be their own lexicographer. It is clear to the undersigned from the telephone interview with the Examiner that he understands that the “scope” as used in the claims is explicitly intended NOT to include the entire address pool – and the claims have been amended to assure that this reading is erroneous. This is clearly evidenced by the suggestion of claim language by the Examiner, which has been adopted. The scope is clearly defined in the specification and an example preferred scope is eight – far less than that defined in RFC 2131 (as was discussed in detail with Examiner Beliveau during the interview in May). Indeed, a reading of a scope consistent with RFC 2131 would be in direct conflict with the teachings of the specification and would result in dramatic increases in processing required at each terminal, defeating an objective of the claimed invention and clearly teaching against the

defined scope, as now defined explicitly in the claims. None of the cited references provide a teaching adequate to teach or suggest this meaning of “scope”, and equally significantly, there is no teaching or suggestion of using DHCP option 12 to define a scope (as now claimed a “household scope”) other than the scope explicitly called for in RFC 2131.

In view of this clear error in interpretation of the “scope” as now explicitly defined in the claims, failure to find a teaching of defining a “scope” using DHCP option 12 in a manner that is in conflict with the scope defined explicitly in RFC 2131, and failure to find this claim feature in any of the cited references, a legal conclusion of *prima facie* obviousness is also erroneous for failure to properly identify each and every claim feature in the prior art. Hence, reconsideration and allowance are respectfully requested.

In order to even more clearly assure that the term “scope” is properly interpreted, the term has been amended to be modified by “household” which is the term explicitly used and defined in the specification. Reconsideration and allowance of all claims are respectfully requested.

In addition, the undersigned cannot find any indication in Mouko that the “including a number for the terminal wherein the number falls within the scope of the subscriber site” (emphasis added). The numbers used in Mouko are not explained as such within Mouko and there is no enabling teaching to support the Office’s position. Thus, the Office further falls short in establishing *prima facie* obviousness for failure to identify this claim feature in the art. Reconsideration and allowance are therefore respectfully requested.

Claims 2-8, 10, 12-18, 21-25, 28-31, and 34-43 depend, directly or indirectly, from one of claims 1, 9, 11, 19, 26 and 32. As such, the applicants submit that these claims are patentable over the combination of Giglio, Arnold, Larson, Muoko and Stapp for at least the foregoing reasons pertaining to claims 1, 9, 11, 19, 26 and 32. Accordingly, reconsideration and allowance are respectfully requested.

Further, with regard to claims 41-43, the Office on the one hand asserts that “scope” is defined by RFC 2131 as the address pool, but suggests that the definition provided by the undersigned in the independent claims would overcome that definition. In claims 41-43, the scope is defined as 8. This is in direct conflict with any address pool referenced in RFC 2131. The teachings of Stapp and Official Notice are used to support rejection of claims 41-43, but this too is inconsistent with RFC 2131 and its definition of use of DHCP option 12. Accordingly, the Office appears to take conflicting positions on the assertion regarding RFC 2131 and Stapp plus Official Notice. The undersigned requires that the Office support the Official Notice with evidence and notes, regarding Official Notice that MPEP2144.04 states:

“In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on “common knowledge” in making a rejection, however such rejections should be judiciously applied. ...”

“While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).”

“It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) (“[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness,

it must provide evidentiary support for the existence and meaning of that theory.”); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) (“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.”).

“It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. ...”

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697. ...”

“Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to “fill in the gaps” in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.”

In view of the above, it is clear that “Official Notice” should be used rarely and is not applicable merely to fill in gaps in an otherwise defective rejection. Reconsideration and allowance are respectfully requested.

Concluding Remarks

Several new amendments to the claims are presented for the Examiner’s consideration.

The undersigned additionally notes that many other distinctions exist between the cited art and the claims. However, in view of the clear distinctions pointed out above in connection with the independent claims, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort. Applicants reserve the right to argue any of the points presented for the rejection of the dependent claims at a later date and makes no concessions as to any of the assertions made by the Office in this Office Action.

Respectfully submitted,

/Jerry A. Miller 30779/

Jerry A. Miller
Registration No. 30,779

Dated: 11/12/09

Please Send Correspondence to:
Jerry A. Miller
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919) 816-9981
Fax: (919) 816-9982
Customer Number 24337